

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Currently, claims 1-6 are pending in the present application of which claims 1-6 are independent.

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cretzler (U.S. Patent Number 5,644,724) in view of Perkowski (6,625,581). The above rejections are respectfully traversed for at least the reasons set forth below.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claim 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cretzler in view of Perkowski. This rejection is respectfully traversed because Cretzler and

Perkowski, considered singly or in combination, fail to teach or suggest the claimed invention as set forth in claims 1-6.

The Applicant asserts that the Office Action has failed to establish a *prima facie* case of obviousness because the Office Action has failed to show how most of the elements in claims 1-6 are allegedly shown or taught by Cretzler or Perkowski. In fact, other than stating that “claims 1-6 are rejected ... over Cretzler in view of Perkowski,” the Office Action does not mention any claim in particular or refer with specificity to any particular element of any claim.

Claim 1, for instance, recites “a first function for receiving an XML-based transaction request from a program controlled system for computation of sales and/or use tax including sales and/or use tax for payments and accruals, verifying the validity of the request and replying to the system with an XML response.” The Office Action seems to interpret this entire element as “receiving a transaction request” and alleges that this is shown by a group of point-of-sale terminals in Cretzler that receive tax collection information. The Applicant asserts that receiving tax collection information has very little to do with the above quoted element of claim 1. For instance, there is no verification regarding the validity of the request, no reply to the system, and no actual request from a program controlled system for computation of ...tax... for payments and accruals. The transaction request shown in Cretzler is a simple transaction request for the purchase of a product at a point-of-sale terminal and has little or nothing to do with “receiving an XML-based transaction request from a program controlled system...”

Additionally, Claim 1 recites “a second function for transforming the transaction request into a master XML-based request file and storing the master request file in a

database.” This element is not mentioned in the Office Action. Additionally, this element cannot be taught or suggested by Cretzler because the disclosure in Cretzler does not accept transaction requests or transform the requests into a file or store it in a master request file.

Claim 1 also recites “a fourth function for transforming the master XML-based request file to a TXP-based file and locating the file in an outbox for retrieval by the financial institution and a fifth function for permitting the financial institution to securely and automatically retrieve the TXP-based file from the outbox.” The Office Action alleges that this is shown in Column 2 Lines 24-35 of Cretzler because “it is inherent that when the bank collects the information from the merchant it must transfer that data into a TPX-based file in order to wire transfer the money to the tax authority.” However, the Applicant asserts that Cretzler fails to show a request file, an outbox, or a function for permitting the financial institution to securely and automatically retrieve the TXP-based file from the outbox. In fact, no outbox is ever mentioned in Cretzler because it discloses a system which requires the merchant to manually activate a microcomputer to transmit tax information. “At the end of each business day, the merchant enters a transmit code into the microcomputer 24 via the input device 22 that causes the microcomputer 24 to send the following tax information to the bank of the merchant...” See Column 4 Lines 53-57.

Claim 1 also recites “a sixth function for securely logging and allowing the third party to review the TXP-based file.” The Office Action alleges that this is shown by Cretzler’s disclosure of a system that obtains approval for credit and debit transactions. Clearly, this cannot be a reasonable interpretation because the Office Action alleges that the TXP file is used to wire money to a tax authority. Therefore, the Applicant asserts that obtaining

approval for a credit and/or debit transaction is in no way similar to allowing a third party to review a TXP-based file.

Claims 2-6 recite elements similar to the elements highlighted above and are allowable for similar reasons. In addition, the Official Action does not rely upon Perkowski to make up for any of these deficiencies in Cretzler with respect to claims 1-6.

At least by virtue of Cretzler's and Perkowski's failure to teach or suggest the above identified elements of claims 1-6, a *prima facie* case of obviousness has not been established under 35 U.S.C. § 103. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1-6.

Improper Final Rejection

The Applicant also asserts that the rejection was improperly made final because the Applicant has not been given an opportunity to meaningfully respond to the rejections set forth in the Office Action. Because the Office Action has failed to refer to any particular claim element of any of the claims 1-6, it is not clear how any of the elements of claims 1-6 are taught or suggested by Cretzler. Therefore, the Applicant has not been given an opportunity to clarify or determine what issues are presented in this matter. The Applicant respectfully requests that if no allowance is forthcoming, the Examiner withdraw the finality of this rejection.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

PATENT

Atty Docket No.: 10011410-2
App. Ser. No.: 09/995,190

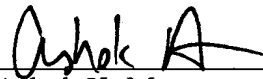
Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Hong Michael DANG

Dated: February 14, 2005

By



Ashok K. Mannava
Registration No.: 45,301

MANNAVA & KANG, P.C.
8221 Old Courthouse Road
Suite 104
Vienna, VA 22182
(703) 652-3822
(703) 880-5270 (facsimile)